In the

United States Court of Appeals

For the Ninth Circuit

TEMPLETON PATENTS, LTD.,
Plaintiff-Appellant,

vs.

J. R. SIMPLOT COMPANY,
Defendant-Appellee.

No. 18899

PETITION FOR REHEARING

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In this Petition, plaintiff-appellant, mindful of the proper role of rehearing, will not reargue the case as a whole, believing that it has already "put its best foot forward," but will limit the area in which rehearing is urged to such part of the Opinion of this Court as deals with the basic Faitelowitz patent and the parts of the Judgment of this Court which were consequent upon that part of its Opinion.

It is plaintiff-appellant's contention that this Court has fallen into a plain error of law in finding in the add-back prior art a significance to the valid scope of the Faitelowitz claim which had never before occurred to appellant or been put forth by appellee or the District Court. The error is made manifest by the logical inconsistency of these two statements from the Opinion of September 4, 1964:

> 'It would appear abundantly clear that application of this well-known method of dehydration [add-back] to cooked potatoes would not constitute invention and that the use of add-back for this purpose could not itself form the basis for a patent." (p. 3)

> 'It would indeed appear that in discovering the effect of two-stage dehydration upon the cellular structure of potatoes Faitelowitz made a discovery of major importance to the industry." (p. 4)

The applicable law indisputably includes:

> **U. S. Const. Art. 1, sec. 8.** "The Congress shall have power . . . To promote the progress of . . . useful art, by securing for limited times to . . . inventors the exclusive right to their . . . discoveries."

Comment:

Hence, if otherwise complying with the statutes enacted by Congress pursuant to this power, the "discovery" of the "inventor" Faitelowitz is clearly patentable.

> **35 U.S.C. Sec. 101.** "Whoever invents or discovers any new and useful process . . . may obtain a patent therefor, subject to the conditions and requirements of this title."

> **35 U.S.C. Sec. 100(b).** "The term 'process' . . . includes a new use of a known process . . ."

Comment:

Although Faitelowitz apparently did not realize it, the best two-stage dehydration process to employ to utilize his discovery was the known process of add-back, among many known specific processes for accomplishing drying of materials other than cooked potatoes in two stages.

IT IS THE ILLOGICAL CONSEQUENCE OF THE OPINION THAT IT HOLDS THAT FAITELOWITZ MADE A PATENTABLE DISCOVERY

ONLY BECAUSE HE DID NOT DISCOVER AND SPECIFICALLY CLAIM THE BEST WAY TO USE HIS DISCOVERY. This is to say, Faitelowitz made his discovery in connection with the less desirable heat approach to two-stage drying and claimed it in a manner not limited to that approach, but this Court now seems to hold that claim can only be infringed by that less desirable approach, because if the best approach, add back, is used, it is inherent in the nature of add-back that it will work. Or, in short, if Faitelowitz had himself hit on the add-back method of practicing his discovery instead of his heat method, he would not have made a patentable discovery since he could not validly claim what he disclosed.

The Opinion (p. 4) goes on to add:

> "It would also appear, however, that as to add-back all this [Faitelowitz's] discovery did was to supply a scientific explanation of why this already well-known method of drying (with its built-in, two-stage process) was particularly well suited to the dehydration of potatoes."

This is contrary to the Congressional mandate of 35 U.S.C. Sec. 100(b) and 101 since the record establishes that two-stage drying, whether by add-back or otherwise, had never before been applied to produce a dry powder from cooked potatoes reconstitutable to a palatable dish of mashed potato. Two-stage drying was, of course, a process old before Faitelowitz for many uses; to use it for the drying of cooked potatoes was a new use of an old process which gave rise to "a discovery of major importance." While it may well be that, granted the pre-existence of Faitelowitz's broad discovery, which he could, and did, properly claim broadly, the known two-stage character of add-back drying made the application of add-back to Faitelowitz obvious. If this is what the Court really meant, it would logically support a judgment that Volpertas' proposal was obvious; it emphatically does not support a judgment that the broad Faitelowitz claim is not infringed.

Nor do the cited decisions of the Supreme Court* support the Court's view that to hold the broad Faitelowitz claim infringed by add-back would "bring within his patent monopoly a principle otherwise available to the public"(Opinion, p. 4). All processes operate in accordance with, and not contrary to, the laws of nature; the principle of heat drying, in one or two or more stages, was, when Faitelowitz made his discovery, no more and no less available to the public than the principle of add-back; by inescapable logic, all patents granted pursuant to 35 U.S.C. Secs. 100(b) and 101 for a new use of an old process must bring with their monopoly a new application of a principle already available to the public. If either of the cited cases, from 1852 and 1948 respectively, could be said to stand for the proposition that a new use of an old process is not patentable, they have, of course, been overruled by the subsequent enactment of the Patent Act of 1952, Title 35, United States Code. They stand, rather, however, for the proposition that a mere statement of a desired result or of an observed natural phenomenon is not patentable, but Faitelowitz disclosed and claimed far more than a result or an observation. He disclosed a specific, and claimed a broad, two-stage drying process with the production of a particular intermediate product, moist powder, which constituted a major industrial breakthrough when applied by add-back.

* LeRoy v. Tatham, 55 U.S. (14 How.) 155, 174 (1852); Funk Bros. Seed Co. v. Kalo Co., 333 U.S. 127 (1948).

This Court should reconsider its ruling affirming, on new grounds, the District Court's holding that appellee was not in infringement of Faitelowitz, for those grounds are clearly unsound.

Respectfully submitted,

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CERTIFICATE OF COUNSEL

I hereby certify that the foregoing Petition for Rehearing is well founded and is not interposed for delay.

CERTIFICATE OF SERVICE

I hereby certify that copies of the foregoing Petition for Rehearing were served on Defendant-Appellee by:

(1) Delivering three copies thereof to the offices of Beale and Jones, 425 Thirteenth Street, N.W., Washington, D.C. on September 18, 1964;

(2) Mailing three copies thereof, airmail postage prepaid, addressed to Hawley, Troxell, Ennis & Hawley, First Security Bank Building, Boise, Idaho.
